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7/30/07

In re Application of:

Deutsch, Harvey L.

Serial No.: 10/566,853

Filed: January 31, 2006

Docket: 15731-1US

Title:

METHOD AND DEVICE FOR
REMOVING AN OCCLUSION

DECISION ON PETITION TO
MAKE SPECIAL FOR NEW
APPLICATION UNDER 37
C.F.R. § 1.102 & M.P.E.P. §
708.02 (VIII)

This is a decision on the petition filed on August 10, 2006 to make the above-identified application special under the accelerated examination procedure set forth in MPEP § 708.02(VIII) and in accordance with 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

In support of the petition, petitioner provides: a) the applicable fee to be charged against the deposit account provided; b) a statement that if all claims are not directed to a single invention, as determined by the Office, applicant will make an election without traverse; c) a certified copy of foreign priority application, WO 2006/071855.

For accelerated examination under MPEP § 708.02(VIII) in accordance with 37 C.F.R. § 1.102(d), a showing of the following is required: a) the applicable petition fee; b) all claims are directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, applicant will make an election without traverse; c) a statement that a pre-examination search was made, listing the field of search by class and subclass; d) a copy of each of the references deemed most closely related to the claimed subject matter; and e) a detailed discussion of the references pointing out with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references.

The requirements of MPEP § 708.02(VIII)(a) and (b) are considered to have been met. However, the petition does not meet the requirements of MPEP § 708.02(VIII) (c)(d) and (e).

Regarding the requirement of MPEP § 708.02(VIII)(c), the relevant portion states that the applicant must "submit statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement if the claims in the corresponding foreign application are the same or similar scope to claims in the U.S. application for which special status is requested." The present petition states that a copy of the International Search Report and the

Written Opinion issued on June 29, 2006 in the parent PCT application are enclosed. However, said documents were not included with the petition. As the petitioner has otherwise failed to provide such statements or evidence of a foreign patent office search, the petition does not meet the requirements of MPEP § 708.02(VIII)(c).

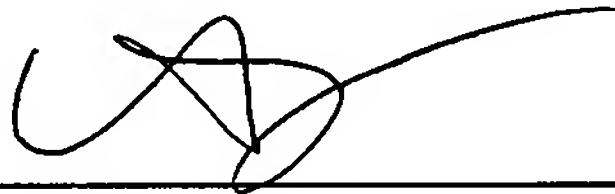
Regarding the requirement of MPEP § 708.02(VIII)(d) the relevant portion states that the applicant must "submit one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record." As a statement regarding the pre-examination search has not been submitted, it is not possible to verify if the petitioners have complied with this requirement. Petitioners should note that a copy of such references would be required upon reconsideration.

Regarding the requirement of MPEP § 708.02(VIII)(e) the relevant portion requires that "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." Additionally, 37 CFR § 1.111 (b) does not allow for general allegations. As the petitioner has failed to provide such an explanation, the petition fails to meet the requirements of MPEP § 708.02(VIII)(e). Upon reconsideration, the petitioners must point out the specific language in each of the independent claims that distinguishes them over each reference cited.

While Technology Center Directors may have granted petitions that do not comply with the detailed discussion requirement of the Accelerated Examination procedure, Technology Center Director decisions on petitions are not binding precedent of the Patent Examining Corps, and the application of an improper standard in certain cases does not require the Office to continue to apply the improper standard in all cases. *See In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003).

For the above-mentioned reasons, the petition is dismissed. The application will, therefore, be taken up by the examiner for action in its regular turn.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely. Any request for reconsideration must provide: a) a statement that a pre-examination search was made, listing the field of search by class and subclass; b) one copy of each of the references deemed most closely related to the subject matter if said references are not already of record; and c) a detailed discussion of the references, which discussion points out with particularity required by 37 CFR §1.111(b) and (c) how the claimed subject matter is patentable over the references.



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